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Martin Kreyenschmidt

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EXAMINER

COONEY, JOHN M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/512,081
Filing Date: November 08, 2004
Appellant(s): KREYENSCHMIDT ET AL.

Stefan Koschmieder
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5-12-09 appealing from the Office action mailed 7-30-08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,847,843	DANY ET AL.	11-1974
DE 100 50 417	KREYENSCHMIDT ET AL.	4-2002
WO 00/66643	ARLT ET AL.	11-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-6,8-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dany et al.(3,847,843) in view of DE 100 50 417.

Dany et al. discloses preparations of polyurethane foam compositions as defined by appellants prepared from isocyanates and polyols containing materials that further include compounds reading on the inhibitors elected by appellants (see column 1 lines 15-23, example 2 & column 5 lines 21-25, as well as, the entire document).

Dany et al. differs from appellants' claims in that they do not encapsulate their active agent in wax. However, DE-'417 discloses that it is known to encapsulate an active agent in wax in polyurethane synthesis operations for the purpose of inhibiting the active agent's effects (see translated abstract, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have encapsulated the active agents of Dany et al. in the manner provided for by DE-'417 for the purpose of inhibiting their active effects in order to arrive at the products and

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processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The additional effects of the waxes and particles of appellants claims are held and maintained to be intrinsic qualities associated with the wax materials provided by the teachings of the prior art and effects arriving from the encapsulation of the materials identified. Additionally, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Claims 1, 3-6, 8-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/66643 in view of DE 100 50 417.

WO-00/66643 discloses preparations of polyurethane foam compositions as defined by appellants prepared from isocyanates and polyols containing materials that further include compounds reading on the inhibitors elected by appellants (see abstract and appellants' admissions at page 2 of their supporting disclosure, as well as, the entire document).

WO 00/66643 differs from appellants' claims in that they do not encapsulate their active agent in wax. However, DE-'417 discloses that it is known to encapsulate an

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active agent in wax in polyurethane synthesis operations for the purpose of inhibiting the active agent's effects (see translated abstract, as well as, the entire document).

Accordingly, it would have been obvious for one having ordinary skill in the art to have encapsulated the active agents of WO-'643 in the manner provided for by DE-'417 for the purpose of inhibiting their active effects in order to arrive at the products and processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The additional effects of the waxes and particles of appellants claims are held and maintained to be intrinsic qualities associated with the wax materials provided by the teachings of the prior art and effects arriving from the encapsulation of the materials identified. Additionally, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

(10) Response to Argument

Appellants' arguments have been considered. However, rejections are maintained. It is held and maintained that the secondary DE-'417 reference is adequate in addressing the deficiencies of the primary references in that it provides for the encapsulation of an active agent in order to inhibit their effects in the systems involved.

Appellants' assertions regarding Dany et al.'s statements that the stabilizers of its invention are not found to affect the foaming process are unpersuasive. Whatever the stabilizers' effects on the systems of Dany et al. may be, whether unobserved by Dany et al., irrelevant to Dany et al.'s concerns, and/or negligible or insignificant, they would have been inhibited by the wax encapsulations provided for by the secondary teachings of DE 100 50 417 & WO 00/66643. Further, it is only seen that the specific foaming process effects being observed by Dany et al.'s teaching are the ones that are unaffected by the stabilizers of Dany et al., and it can not be extrapolated from these statements of Dany et al. that the stabilizers of Dany et al. have no effect whatsoever on systems within which they are employed. Moreover, one looking to inhibit or delay the stabilizing effects of the stabilizers during the foaming process would have been motivated to employ the wax encapsulations provided for by DE 100 50 417 and/or WO 00/66643 in order to do so. Finally, motivation to combine teaching of the prior art may come from all of the teachings of the cited prior art, including the secondary teaching.

As to appellants' assertions that the instant inventors are concerned with achieving different effects are unpersuasive and they do not substitute for the required fact based showing of new or unexpected results that are commensurate in scope with the scope of their claims.

Showings of new or unexpected results need to establish the following:

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Appellants' have not persuasively demonstrated unexpected results for the encapsulations of the agents of their claims. Appellants have not clearly demonstrated their results to be unexpected and more than mere optimizations of the knowledge in the art or more significant than being secondary in nature. Appellants' have not

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demonstrated their showings to be commensurate in scope with the scope of the products and processes as claimed.

Appellants' have not demonstrated factually how the evidence of record demonstrates results that are, in fact, unexpected over what would be expected from what is taught and fairly suggested by the combined teachings of the cited prior art. The delay of the effects of the indicated materials on the systems in which they are employed is not seen to be unexpected based on the combined teachings of record, and appellants have not demonstrated the evidence of the results of their examples to be more significant than what would be expected from the combined teachings of the cited prior art. Further, it is maintained that these required showings of new or unexpected results are lacking for the scope polyurethane materials, ranges of amounts and selections of inhibitors, and the various wax materials encompassed by the elected invention of appellants' claims.

Additionally, it is further noted that where a definite comparative standard may be used, the comparison must relate to the prior art embodiment relied upon and not other prior art – *Blanchard v. Ooms*, 68 USPQ 314 – and must be with a disclosure identical (not similar) with that of said embodiment: *In re Tatincloux*, 108 USPQ 125. In the instant case appellants have not offered comparisons with the prior art embodiments of the cited prior art.

As to appellants' arguments specifically directed towards WO 00/66643, it is not seen that the fact that specifics of WO 00/66643 are involved with encapsulating a catalyst negates the rejection over the combination of its teaching with that of Dany et

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al. The secondary teaching is looked to for its disclosure of encapsulation for purposes of delaying/inhibiting the active agent's effects.

As to the specific dependent claims mentioned in appellants' arguments, claim 12 is a withdrawn claims and has not been examined at this time, and claims 11 and 18 are not drawn to specific inhibitors from within the elected group of α,β -unsaturated compounds examined that would distinguish these claims over the combined teachings of the cited prior art.

It is held and maintained that the elected invention of applicants' claims are properly rejected over the combined teaching of the cited prior art as indicated in the rejections as set forth above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John M. Cooney, Jr.

/John Cooney/

Primary Examiner, Art Unit 1796

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